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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/709,020

11/08/2000

Christoph Benning

MSU-04769

3130

23535

7590

05/23/2002

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EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 05/23/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/709,020

Applicant(s)

BENNING ET AL.

Examiner

Yong Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2002 has been entered.

Claims 1, 13 and 15-16 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: it is unclear how the peptides are reacted with UDP-glucose and UDP-SQ, whether the peptides are cultured from the host cells and reacted with UDP-glucose and UDP-SQ or if the starting products of each reaction already exist in the host cell. Also the steps in isolating the final product is missing.

***Claim Rejections - 35 USC § 103***

Claims 1, 13 and 15-16 are rejected under 35 U.S.C. 103(a) as being obvious over Benning in view of Essigmann et al. and Guler et al.

Benning (form PTO-1449) teach SQDG biosynthesis is a two-step reaction starting with UDP-glucose as the precursor to UDP-SQ (UDP-sulfoquinovose), which is the precursor to SQDG (page 61, 2<sup>nd</sup> paragraph). In addition, Benning teaches a pathway for the production of UDP-SQ from UDP-glucose with SQDB protein and a pathway for the production of SQDG from UDP-glucose with sqdX as the enzyme that converts UDP-SQ into SQDG (figure 3, page 62). Benning teaches that sqdX from *Synechococcus* sp. Catalyzes the reaction of UDP-SQ into SQDG. SqdX is inherently identical to SEQ ID NO:1 of the instant invention, as evidenced by Guler et al. (page 545, 1<sup>st</sup> paragraph).

Benning also teach that sulfite can be used as the sulfur donor (page 66, 2<sup>nd</sup> paragraph). <sup>Benning</sup>Essigmann et al. also teach that SQDG of photosynthetic bacteria and plants are a promising anti-tumor and anti-HIV therapeutic (page 54, 1<sup>st</sup> paragraph). Transfecting a host cell with a desired gene is well known and practiced in the art (see Hall et al. – background).

The difference between the reference of Benning and the instant invention is that the reference of Benning does not teach a method of producing UDP-SQ from UDP-glucose with the polypeptide encoded by SEQ ID NO:6.

Essigmann et al. teach a polypeptide, plant SQD1, that catalyzes the formation of a UDP-sulfoquinovose from UDP-glucose and is orthologous to the SQDB (page 31, 4<sup>th</sup>

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paragraph and page 39). The SQD1 gene is 100% identical to SEQ ID NO:6 of the instant invention (GenEmbl database – Accession # AF022082). Essigmann et al. teach that said SQD1 gene and the bacterial sqdB gene (as mentioned above) are the only sulfolipid genes known to be conserved between different organisms (page 31, 5<sup>th</sup> paragraph).

Essigmann et al. teach a method for transfecting a host cell with a DNA to express the encoded enzyme (page 32, 5<sup>th</sup> paragraph). Although Essigmann et al. states that the sulfur donor is unknown, Essigmann et al. teaches that a sulfite is a plausible sulfur donor (page 40, 3<sup>rd</sup> paragraph).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to substitute the first reaction of SQDG synthesis of Benning with the SQD1 enzyme of Essigmann et al. The motivation of using the SQD1 is to provide a system in synthesizing SQDG using genes from a plant source and a bacterial source, thereby possibly increasing efficiency in production of SQDG. An efficient production of SQDG is attractive because sulfolipids are possible anti-tumor and anti-HIV therapeutics. One of ordinary skill in the art would have had a reasonable expectation of success since Benning outlines the pathway for SQDG production and production of a product using heterologous or orthologous enzymes are routinely performed in the art.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

May 21, 2002



PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800